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13 FIFTY-SIX HOPE ROAD MUSIC LIMITED and ZION
ROOTSWEAR, LLC
14

15 **UNITED STATES DISTRICT COURT**
16 **DISTRICT OF NEVADA**

17 Fifty-Six Hope Road Music, Ltd., a
Bahamian corporation; and Zion
18 Rootswear, LLC, a Florida limited
liability company,

19 Plaintiffs,

20 vs.

21 A.V.E.L.A., Inc., a Nevada corporation;
22 Sci-Fi Productions, Inc. dba X One X
Movie Archive, Inc., a Nevada
23 corporation; JEM Sportswear, a
California corporation; Central Mills,
24 Inc. (Freeze), a New York corporation;
and Leo Valencia, an individual,

25 Defendants.
26

27 AND RELATED COUNTERCLAIM.
28

Case No. 2:08-cv-00105-PMP-GWF

**PLAINTIFFS' MOTION IN LIMINE #9 TO
EXCLUDE CERTAIN DESIGNATED
DEPOSITION TESTIMONY OF GREGG
PARADISE BASED ON IT BEING
IMPERMISSIBLE EXPERT TESTIMONY**

Pretrial Conference: January 3, 2011
Time: 1:30 p.m.
Location: Courtroom 7C,
Hon. Philip M. Pro

1 **I. INTRODUCTION AND BACKGROUND**

2 By this motion, Plaintiffs Fifty-Six Hope Road Music, Ltd. ("Fifty-Six Hope Road")
 3 and Zion Rootswear, LLC ("Zion") (collectively, "Plaintiffs") respectfully request the Court
 4 to enter an order barring Defendants A.V.E.L.A., Inc. ("AVELA"), Leo Valencia, Sci-Fi
 5 Productions, Inc., JEM Sportswear, and Central Mills, Inc. (Freeze) (collectively,
 6 "Defendants") from offering certain designated deposition testimony of Gregg Paradise.

7 First, Defendants seek to offer excerpts from Mr. Paradise's depositions that do
 8 not reflect advice or counsel which Mr. Paradise offered to Defendants but, rather,
 9 consist of Mr. Paradise offering his opinion on intellectual property law. Such evidence
 10 must be excluded on at least two bases: (1) Defendants failed to designate Mr. Paradise
 11 as an expert witness; and (2) even if Defendants had designated Mr. Paradise as an
 12 expert witness, he is not, as a so-called expert, permitted to testify as to what he
 13 happens to believe the relevant law is. Defendants' attempts to offer expert testimony
 14 from Mr. Paradise on what he claims the law is improper and must be excluded.

15 Next, despite the dismissal of Plaintiffs' claims for Trademark Infringement under
 16 15 U.S.C. § 1114, Trademark Infringement under the Common Law, and Unauthorized
 17 Commercial Use of Right of Publicity under NRS § 597.770, *et seq.* (collectively, "the
 18 Dismissed Claims"), Defendants have not withdrawn deposition designations that relate
 19 solely to advice Mr. Paradise gave Defendants regarding the Dismissed Claims. This
 20 testimony is irrelevant to Plaintiffs' remaining claims, will almost certainly confuse the
 21 jury, and must be excluded. Similarly, Defendants refuse to withdraw deposition
 22 designations that address the *Tunes* case (as defined *infra*), evidence of which, pursuant
 23 to the Court's granting of Plaintiffs' Motion *in Limine* No. 5, is excluded from trial. This
 24 testimony must also be excluded.

25 **II. SUMMARY OF MATERIAL FACTS**

26 Although not plead as an affirmative defense (which it is), Defendants have
 27 alleged that they acted on the advice of counsel in connection with their unauthorized
 28 use of Bob Marley's image on apparel and merchandise. Plaintiffs deposed Mr.

1 Paradise to elicit the content of the advice that Mr. Paradise gave AVELA regarding use
2 of Bob Marley's image on apparel and merchandise. Most of that testimony related to
3 the right of publicity claim that had been alleged. Subsequent to their depositions of Mr.
4 Paradise and the parties' respective designations of excerpts from Mr. Paradise's
5 depositions for presentation at trial, the Court dismissed Plaintiffs' right of publicity claim
6 under NRS 597.770, *et seq.* (Docket No. 224.) In addition, since making said
7 designations, the Court also granted Defendants' Motion *in Limine* No. 3 to exclude
8 evidence of Plaintiffs' registrations of TUFF GONG & Design, ROOTS ROCK REGGAE,
9 and CATCH A FIRE (Docket No. 210), and Plaintiffs' Motion *in Limine* No. 5 to exclude
10 reference of or evidence related to *Fifty-Six Hope Road Music Limited v. Mayah*
11 *Collections*, Case No. 2:05-CV-05-1059-KJD-GWF ("*Tunes*"). (Docket No. 204.)

12 Since then, and given the dismissal of the right of publicity claim and the Court's
13 granting of Defendants' Motion *in Limine* No. 3 and Plaintiffs' Motion *in Limine* No. 5,
14 Plaintiffs have sought to collaborate with Defendants on paring down their respective
15 designations of excerpts from Mr. Paradise's depositions for presentation at trial.
16 Specifically, Plaintiffs emailed Defendants a list of certain deposition designations that
17 had been rendered irrelevant to Defendants' unpleaded advice of counsel affirmative
18 defense due to these subsequent events. (Pietrini Decl. ¶ 3, Ex. A.) However,
19 Defendants have refused to withdraw their designations for presentation at trial. (Pietrini
20 Decl. 4, Ex. B.) The deposition excerpts at issue are attached hereto. (Pietrini Decl. 5,
21 Ex. C.)

22 Defendants have not designated any expert witnesses in this matter. Defendants
23 have never held Mr. Paradise out as an intellectual property law expert or represented
24 that they were seeking expert testimony from Mr. Paradise. (Pietrini Decl. ¶ 6.) Yet that
25 is what Defendants clearly intend to do by trying to use the contested deposition
26 testimony of Mr. Paradise.

1 **III. LEGAL ARGUMENT**

2 **A. Gregg Paradise's Testimony Is Improper Expert Opinion and Must Be**
 3 **Excluded**

4 Throughout his deposition, Mr. Paradise volunteered testimony that amounted to
 5 his opinion on what the law provides, as opposed to the actual advice he claims he
 6 offered Defendants. Defendants now seek to offer this testimony, essentially turning Mr.
 7 Paradise into an undesignated expert designed to instruct the jury on what the law –
 8 purportedly – is. This is improper. Accordingly, the Court must preclude Defendants
 9 from presenting what is clearly intended as expert opinion of Mr. Paradise. Mr.
 10 Paradise's testimony must be confined to matters relevant to Defendants' unpleaded
 11 advice of counsel affirmative defense. As noted herein, in the event that the Court does
 12 allow Defendants to present the expert testimony of Mr. Paradise, Plaintiffs must, in turn,
 13 be allowed to present evidence of the fact that certain songs and albums titles of Bob
 14 Marley's that Defendants used on their merchandise in conjunction with images of Bob
 15 Marley were registered trademarks that Mr. Paradise ignored or never considered in his
 16 analysis.

17 **1. Defendants Have Not Designated Gregg Paradise as an Expert**
 18 **Witness**

19 “[A] party must disclose to the other parties the identity of any witness it may use
 20 at trial to present evidence under Federal Rule of Evidence 702, 703, or 705.” FRCP
 21 26(a)(2). “If a party fails to provide information or identify a witness as required by Rule
 22 26(a) or 26(e), the party is not allowed to use that information or witness to supply
 23 evidence on a motion, at a hearing, or at a trial, unless the failure was substantially
 24 justified or is harmless.” FRCP 37(c)(1). Defendants have not designated any expert
 25 witnesses. Rule 26 is clear that the portion of Mr. Paradise's testimony that constitutes
 26 expert opinion on the law must be excluded. To allow Defendants, despite the
 27 aforementioned omissions, to use Mr. Paradise as an expert witness would be clearly
 28 inappropriate and prejudicial to Plaintiffs who have never had reason or cause to treat

1 Mr. Paradise as an expert witness, discover the content and bases of his now expert
 2 opinion on intellectual property law, and designate a counter-expert designed to instruct
 3 the jury on intellectual property law.

4 **2. Even if Defendants Had Designated Gregg Paradise as an**
 5 **Expert Witness, His Testimony Would be Inadmissible**

6 Expert testimony is not admissible to inform the jury as to the law that it will be
 7 instructed to apply to the facts in deciding the case. That is a matter reserved exclusively
 8 for the Court. “Whether expert opinion testimony is ‘otherwise admissible’ depends, in
 9 part, on whether it will ‘assist the trier of fact’ in either ‘understanding the evidence or ...
 10 determining a fact in issue.’ [Citation to FRE 702.] Expert testimony that consists of
 11 legal conclusions cannot properly assist the trier of fact in either respect, and thus it is
 12 not ‘otherwise admissible.’” *Burkhart v. Washington Metro. Area Transit Auth.*, 112 F.3d
 13 1207, 1212 (D.C. Cir. 1997), *citing Torres v. County of Oakland*, 758 F.2d 147, 150 (6th
 14 Cir. 1985). “Each courtroom comes equipped with a ‘legal expert,’ called a judge, and it
 15 is his or her province alone to instruct the jury on the relevant legal standards.” *Burkhart*,
 16 112 F.3d at 1213.

17 Defendants have designated certain excerpts of Mr. Paradise’s depositions that
 18 seek to inform the jury as to the law it will be instructed to apply to the facts in deciding
 19 the case.¹ These excerpts do not relate to any advice Mr. Paradise provided Defendants
 20 regarding their potential liability for false association and endorsement under 15 U.S.C. §
 21 1125(a). Mr. Paradise testified that he did not recall discussing 15 U.S.C. § 1125(a)
 22 specifically with Mr. Valencia of AVELA. (Pietrini Decl. ¶ 5, Ex. C, Paradise II, 39:6-12
 23 and 39:21-23.) Rather, these excerpts feature Mr. Paradise’s opinions on liability under
 24 15 U.S.C. § 1125(a), including whether the use of a musical artist’s album and/or song
 25 titles should or is likely to result in or factor into liability for false association and
 26 endorsement. However, all that matters is what Mr. Paradise specifically recalls directly

27 ¹ See Pietrini Decl. ¶ 5, Ex. C, Paradise II 23:4-9, 34:10-25, 35:2-25, 36:2-25, 37:2-
 28 25, 38:2-25, 39:2-25, 40:2-11, 40:22-25, 41:2-8, 43:7-23, 44:5-25, 45:2-25, 46:2-25 and
 47:2-7.

1 discussing with Defendants about the claims and defenses asserted in this case. Mr.
2 Paradise's opinions on liability in general for uses of others' music titles in unfiled cases
3 are inappropriate for jury consideration. Not only has Mr. Paradise not been properly
4 designated as an expert witness, but even had he been, this testimony impermissibly
5 opines upon liability under 15 U.S.C. § 1125(a) and interferes with the Court's exclusive
6 role as the decider of legal issues.

7 **3. If Defendants Are Not Precluded From Presenting Mr. Paradise**
8 **as an Expert Witness, Plaintiffs Must be Allowed to Present**
9 **Evidence of Certain Trademark Registrations Previously Ruled**
10 **Inadmissible by the Court**

11 Mr. Paradise testified as to his opinion on whether the use of a musical artist's
12 album and/or song titles is likely to result in or factor into liability for false association and
13 endorsement. Although Mr. Paradise's legal conclusions on this issue constitute an
14 incorrect understanding of the law, even Mr. Paradise acknowledges that his opinion
15 may change were he to learn that the songs and/or album titles were also registered
16 trademarks. (Pietrini Decl. ¶ C, Ex. 5, Paradise II 44:5-25.) Accordingly, if Defendants
17 are allowed to present this opinion testimony to the jury, Plaintiffs must, in turn, be
18 allowed to present evidence of their registrations and applications to register the
19 trademarks ROOTS ROCK REGGAE, CATCH A FIRE, ONE LOVE, and TUFF GONG &
20 Design. It would be patently unfair and prejudicial to Plaintiffs to allow Defendants to
21 present expert testimony regarding Defendants' liability under 15 U.S.C. § 1125(a) for
22 use of song and album titles without allowing Plaintiffs to present evidence of their
23 trademark rights in certain song and album titles used by Defendants on their
24 merchandise and apparel. If Plaintiffs are precluded from presenting this evidence, the
25 jury's assessment of how Defendants' use of Bob Marley's album and song titles on their
26 merchandise impacts the likelihood of confusion analysis will be woefully incomplete, all
27 to the prejudice of Plaintiffs. Indeed, Plaintiffs believe they should be allowed to present
28 this evidence in any event. But regardless, allowing expert testimony from Mr. Paradise
on the law allegedly is, is patently improper.

1 **B. Gregg Paradise's Testimony Relating to Plaintiffs' Dismissed Claims**
 2 **is Irrelevant and Must Be Excluded**

3 Plaintiffs' claims that Defendants violated Plaintiffs' registration of their right of
 4 publicity in Bob Marley and infringed Plaintiffs' BOB MARLEY trademark were dismissed
 5 by the Court. Nevertheless, Defendants refuse to withdraw designations of Mr.
 6 Paradise's testimony that relate only or substantially to advice given by Mr. Paradise to
 7 Defendants as to whether their actions violated Plaintiffs' registration of its right of
 8 publicity or infringed Plaintiffs' BOB MARLEY word mark.² This testimony is irrelevant to
 9 Plaintiffs' remaining claims for false association and endorsement under 15 U.S.C. §
 10 1125(a) and intentional interference with prospective economic advantage. If
 11 Defendants are permitted to introduce this evidence, it will result in significant jury
 12 confusion, including, but not limited to, confusion as to which intellectual property rights
 13 form the basis for Plaintiffs' claim under 15 U.S.C. § 1125(a). As such, this testimony
 14 must be excluded.

15 **C. Gregg Paradise's Testimony Relating to the *Tunes* Case Must Be**
 16 **Excluded**

17 In connection with a motion *in limine*, the Court has ordered the parties not to
 18 present any evidence of or related to the *Tunes* case. Yet, even after obtaining that
 19 ruling, Defendants stubbornly refuse to withdraw designations of Mr. Paradise's
 20 testimony that specifically address and relate to the *Tunes* case.³ Defendants' refusal is
 21 inconsistent with the Court's ruling, and if Defendants are allowed to offer this evidence,
 22 it will, undoubtedly, engender jury confusion. As such, this testimony must be excluded.

23 ///

24 ///

25 _____
 26 ² See Pietrini Decl. ¶ 5, Ex. C, Paradise I, 12:22-25, 13:2-7, 14:8-18, 19:2-5, 56:15-
 27 25, 57:1-3, 63:16-22, 93:8-25, 94:1-25, 95:2, 105:2-11, 105:23-25, 106:2-25, 116:22-25,
 28 117:2-25, 118:2-25, 119:2-5, 126:20-25, 127:2, 133:14-23, 164:2-12, 166:22-25, 167:2-
 25, 168:2-13 and 173:4-16; Paradise II, 11:11-25, 12:2-5 and 16:5-22.

28 ³ See Pietrini Decl. ¶ 5, Ex. C, Paradise I, 93:8-25, 94:1-25, 95:2 and 115:9-14.

1 **IV. CONCLUSION**

2 For all the foregoing reasons, Plaintiffs respectfully request that the Court enter an
3 order precluding Defendants from presenting certain deposition testimony of Gregg
4 Paradise.

5 Respectfully submitted,

6 MANATT, PHELPS & PHILLIPS LLP

7 Dated: January 3, 2011

8 By: /s/Jill M. Pietrini

9 Jill M. Pietrini

10 *Attorneys for Plaintiffs and Counter-*
11 *Defendants*

12 *FIFTY-SIX HOPE ROAD MUSIC*
13 *LIMITED and ZION ROOTSWEAR, LLC*

DECLARATION OF JILL M. PIETRINI

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3 1. I am over the age of 18, I have personal knowledge of the facts set forth
4 herein, and I make this Declaration in support of Plaintiffs motion *in limine* for an order
5 precluding Defendants from presenting certain testimony of Gregg Paradise.

6 2. I am an attorney with Manatt, Phelps & Phillips, LLP ("Manatt") and am
7 counsel of record for Fifty-Six Hope Road in this matter. I have personal knowledge of
8 the facts set forth herein, and if called upon to do so, I could and would competently
9 testify thereto.

10 3. Due the Court's ruling on the parties motions *in limine* and the dismissal of
11 Plaintiffs' right of publicity claim, I sought to collaborate with Defendants' counsel, Doug
12 Winter, on paring down the parties' respective designations of excerpts from Mr.
13 Paradise's depositions for presentation at trial. Specifically, on December 29, 2010, I
14 emailed Defendants' counsel, Doug Winter, a list of certain deposition designations that
15 had been rendered irrelevant to Defendants' unpleaded advice of counsel affirmative
16 defense due to the dismissal of Plaintiffs' right of publicity and trademark infringement
17 claims, and rulings on the parties' motions *in limine*. A true and correct copy of my
18 December 29, 2010 email to Mr. Winter is attached hereto as **Exhibit A**.

19 4. On December 30, 2010, Mr. Winter responded to my email and indicated
20 the deposition designations that Defendants would agree to withdraw. A true and
21 correct copy of Mr. Winter's December 30, 2010 email is attached hereto as **Exhibit B**.

22 5. The designations from Plaintiffs' depositions of Mr. Paradise at issue are
23 as follows: 12:22-25, 13:2-7, 14:8-18, 19:2-5, 56:15-25, 57:1-3, 63:16-22, 93:8-25, 94:1-
24 25, 95:2, 105:2-11, 105:23-25, 106:2-25, 115:9-14, 116:22-25, 117:2-25, 118:2-25,
25 119:2-5, 126:20-25, 127:2, 133:14-23, 164:2-12, 166:22-25, 167:2-25, 168:2-13 and
26 173:4-16 of Plaintiffs' deposition of Gregg Paradise on October 14, 2009 ("Paradise I");
27 and 11:11-25, 12:2-5, 16:5-22, 23:4-9, 34:10-25, 35:2-25, 36:2-25, 37:2-25, 38:2-25,
28 39:2-25, 40:2-11, 40:22-25, 41:2-8, 43:7-23, 44:5-25, 45:2-25, 46:2-25 and 47:2-7 of

1 Plaintiffs' deposition of Gregg Paradise on April 8, 2010. These excerpts are attached
2 hereto as **Exhibit C**.

3 6. Defendants have not designated any expert witnesses in this matter.
4 Defendants have never held Mr. Paradise out as an intellectual property law expert or
5 represented that they were seeking expert testimony from Mr. Paradise. Given the
6 nature of the testimony of Mr. Paradise that Defendants refuse to withdraw, I believe that
7 Defendants intend to use the challenged Paradise testimony to make Mr. Paradise their
8 intellectual property law expert.

9 I declare under penalty of perjury under the laws of the United States that the
10 foregoing is true and correct. Executed this 3rd day of January, 2011 at Las Vegas,
11 Nevada.

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13 /s/Jill M. Pietrini
14 Jill M. Pietrini
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(EXHIBIT A)

EXHIBIT A

Martin, Latrina

From: Pietrini, Jill
Sent: Wednesday, December 29, 2010 5:26 PM
To: 'Doug Winter'; Bost, Paul
Subject: RE: Exhibits, Deposition Designations and Financial Documents
Attachments: Deposition Designations.pdf

Doug:

There are a few points that we need to address before the trial, and we respond to your emails to Barry and I today. Note that we did respond to your initial email of December 23rd.

Deposition Designations

We will include our revised deposition designations along with the portions of Defendants' designations which overlap with ours. You are responsible for presenting the portions of your deposition designations that you intend to present to the jury.

Given the stipulation as to the financial numbers and the dismissal of the right of publicity and trademark infringement claims, we have pared down our designations to remove irrelevant or mooted testimony and we will be asserting additional objections to the testimony that Defendants have designated on the same grounds. We are attaching a chart of those deleted designations and the additional objected to designations of Defendants. We ask that you voluntarily agree to withdraw the designations that are identified in the attached chart, under Additional Objections to Defendants' Designations. Let us know immediately if you agree to do so.

We will file our revised deposition designations with the Court shortly.

Exhibits

You have a list of the exhibits that we intend to introduce. We have made our trial binders with those exhibits, and we have not changed the exhibit numbers, as I stated to the Court. To the extent the parties are using the same exhibits, they will be included in our binders. If you are using additional exhibits, not on our list, we don't have them. We will make a set of trial exhibit books for the Court, the judge, and ourselves. You are responsible for making your own trial exhibit books. As for exhibits you claim that you do not have, please identify those to us and we will send you copies. We believe that we have produced all of the documents identified on our exhibit list.

Stipulation of Fact on the Financial Information

You probably noticed this, but just in case, the Court entered the stipulation today. We will include the Stipulation as an additional trial exhibit. We are still waiting for a response to Barry Mallen's email this morning about stipulating to the authenticity of the underlying financial documents to avoid unnecessary testimony at trial authenticating those documents. The purpose of having a stipulation as to authenticity of financial documents is if they are offered to prove something else, e.g., dates that items sold, etc. We don't know if they will be used for other purposes, but in case they are, we would prefer to have a stipulation as to their authenticity. Please let us know your position. Thank you.

From: Doug Winter [mailto:dwinter@balllawllp.com]
Sent: Wednesday, December 29, 2010 4:57 PM
To: Pietrini, Jill; Bost, Paul
Subject: FW: Exhibits

1/3/2011

I left a voicemail for Paul yesterday, but no response. I need to speak with someone regarding the exhibits. It's been nearly a week now. Please let me know when someone is available asap.

Thanks.

Douglas D. Winter
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From: Doug Winter
Sent: Thursday, December 23, 2010 1:12 PM
To: 'Pietrini, Jill'
Subject: RE: Exhibits

Jill:

I just left you a message on your voicemail. As to the stip, there are a few discrepancies with the numbers, and we can hopefully resolve that without a problem. However, more fundamentally, as to gross receipts, the amount should be limited to Jem and Freeze, because they are the defendants in the case. The receipts from non-party licensees are relevant for the purpose of calculating Avela's license fees.

As to the exhibits, if we are able to pare them down, are Plaintiffs anticipating changing any of their exhibit numbers from the PTO? If not, it doesn't seem to me that we need to wait for the stip to be finalized. Please let me know your thoughts on this.

Doug

Douglas D. Winter
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From: Pietrini, Jill [mailto:JPietrini@manatt.com]
Sent: Wednesday, December 22, 2010 6:25 PM
To: Doug Winter
Cc: Bost, Paul; Mallen, Barry; Tim Ervin
Subject: Exhibits

Doug: Case 2:08-cv-00105-PMP-GWF Document 251 Filed 01/03/11 Page 14 of 70

I received your voicemail yesterday about meeting about the trial exhibits. We need your signature on the stipulation about sales and revenue before we can do anything about exhibits. Assuming that you will actually sign the stipulation, that will eliminate a lot of trial exhibits both for live witnesses and for the deposition witnesses, and we can pare down the exhibits. You need to send us the signed stipulation or tell us that you are not signing it.

Also, have you updated your exhibit list?

Jill Pietrini
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(310) 312-4224 (main fax)
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DEPOSITION DESIGNATIONS**WET SEAL – NICOLE BARKER**

<u>Further Objections to Defendants' Designation</u>
5:11-22
80:20-25,81:1
84:8-17
<u>Withdraw of Plaintiffs' Objections</u>
125:17-24
81:14-16, 18-22

<u>Financial Testimony & Documents to Delete</u>
105:13-23
106:11-25
107:1-25
108:4-6, 10-12
109: 7-15,19-23

ECKO LTD – ANDREW CUNNINGHAM

<u>Plaintiffs' Designations to Withdraw</u>
6:18-23
22:19-25
23:2-4
56:11-23

<u>Additional Objections to Defendants' Designations</u>
66:21

ECKO LTD. – STEVEN FEFFERMAN

<u>Additional Objections to Defendants' Designations</u>
63:12-19
113:24-25; 114:2-4

JGR COPA – JACOB GOLDZER

<u>Additional Designations by Plaintiffs</u>
79:15-16
<u>Withdrawal of Plaintiffs' Designation</u>
34:13-17
41:10-14
113:8-25; 114:1-25; 115:1-20
<u>Additional Objections to Defendants' Designations</u>
28:23-25, 29:1-2
58:22-25; 59:1-5
113:21-25, 114:1; 115:4-19

<u>Financial Testimony & Documents to Delete</u>
64:1-25, Ex. 109; 65:1-25; 66:1-8; 69:5-25, 70:14-25; 71:1-15, 74:9-18, 22-25; 75:1-25 (Ex. 110); 76:1-25; 77:1-23; 78:1-25; 79:1-14; 81:21-25; 82:1-25; 83:1-18; 85:12-24

JAMES PETTIT

<u>Additional Objections to Defendants' Designations</u>
20:6

THE HOUSE – RABINOWITZ

<u>Additional Objections to Defendants' Designations</u>
46:211
47:214-217
61:283-285; 62:286-291; 63:292
64:301

<u>Financial Testimony & Documents to Delete</u>
43:191-193; Ex. 3
44:194-197
45:206-207
49:223-224
50: 224-230
51:230-235
52:236-239, Ex. 59

TARGET – HEATHER VOGEL

<u>Additional Objections to Defendants' Designations</u>
70:13-16
83:8-17
84:4-10
85:14-23
111:11-12

<u>Financial Testimony & Documents to Delete</u>
99:17-25
100:1-24, Ex. 187
101: 10-25, Ex. 188
102:1-14
103:1-14
104:1-25
105:1-14, 17-25; Exs. 189, 190
106:1, 16-25, Ex. 191
107:1-25
108:1-8
109:1-8, 14-15
110:10-21

BALZOUT – SCOTT HOLROYD

<u>Plaintiffs' Designations to Add</u>
9:18-12
<u>Additional Objections to Defendants' Designations</u>
57:8-17
89:4-12

<u>Financial Testimony & Documents to Delete</u>
107:25
108:1-25
109:1-23, Ex. 101
111:15-25
112:1-9
112:14-19 (Ex. 102)
113:12-25
114:1-7, 11-25
115:1-3

TARGET – ELIZABETH KINNEBERG

<u>Plaintiffs' Designations to Delete</u>
70:3-15
140:17-21
<u>Additional Objections to Defendants' Designations</u>
70:12-15
74:2-6
137:5-22

<u>Financial Testimony & Documents to Delete</u>
116:1-12, 17, 24-25, Exs. 180 & 181
117:1-25
118:1-4
122:20-25
123:1-25
124:1-17

GREGG PARADISE

<u>Additional Objections to Defendants' Designation</u>
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300194927.1

(EXHIBIT B)

EXHIBIT B

Martin, Latrina

From: Doug Winter [dwinter@balllawllp.com]
Sent: Thursday, December 30, 2010 1:21 PM
To: Pietrini, Jill; Bost, Paul
Subject: RE: Exhibits, Deposition Designations and Financial Documents

In response to the Deposition Designations, Defendants additionally designate 115:24-116:16 from the Goldzer deposition.

Defendants agree to withdraw the following designations:

Jacob Goldzer

28:23-25, 29:1-2

James Petit

20:6

Joel Rabinowitz

-
46:211
47:214-217

Greg Paradise (Day 1)

119:15-19

Greg Paradise (Day 2)

-
14:11-25; 15:2-7
28:12-22
61:7-25; 62:2-7

Douglas D. Winter
THE BALL LAW FIRM, LLP
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Los Angeles, CA 90024
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www.balllawllp.com

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From: Pietrini, Jill [mailto:JPietrini@manatt.com]
Sent: Wednesday, December 29, 2010 5:26 PM
To: Doug Winter; Bost, Paul
Subject: RE: Exhibits, Deposition Designations and Financial Documents

Doug:

1/3/2011

There are a few points that we need to address before the trial, and we respond to your emails to Barry and I today. Note that we did respond to your initial email of December 23rd.

Deposition Designations

We will include our revised deposition designations along with the portions of Defendants' designations which overlap with ours. You are responsible for presenting the portions of your deposition designations that you intend to present to the jury.

Given the stipulation as to the financial numbers and the dismissal of the right of publicity and trademark infringement claims, we have pared down our designations to remove irrelevant or mooted testimony and we will be asserting additional objections to the testimony that Defendants have designated on the same grounds. We are attaching a chart of those deleted designations and the additional objected to designations of Defendants. We ask that you voluntarily agree to withdraw the designations that are identified in the attached chart, under Additional Objections to Defendants' Designations. Let us know immediately if you agree to do so.

We will file our revised deposition designations with the Court shortly.

Exhibits

You have a list of the exhibits that we intend to introduce. We have made our trial binders with those exhibits, and we have not changed the exhibit numbers, as I stated to the Court. To the extent the parties are using the same exhibits, they will be included in our binders. If you are using additional exhibits, not on our list, we don't have them. We will make a set of trial exhibit books for the Court, the judge, and ourselves. You are responsible for making your own trial exhibit books. As for exhibits you claim that you do not have, please identify those to us and we will send you copies. We believe that we have produced all of the documents identified on our exhibit list.

Stipulation of Fact on the Financial Information

You probably noticed this, but just in case, the Court entered the stipulation today. We will include the Stipulation as an additional trial exhibit. We are still waiting for a response to Barry Mallen's email this morning about stipulating to the authenticity of the underlying financial documents to avoid unnecessary testimony at trial authenticating those documents. The purpose of having a stipulation as to authenticity of financial documents is if they are offered to prove something else, e.g., dates that items sold, etc. We don't know if they will be used for other purposes, but in case they are, we would prefer to have a stipulation as to their authenticity. Please let us know your position. Thank you.

From: Doug Winter [mailto:dwinter@balllawllp.com]
Sent: Wednesday, December 29, 2010 4:57 PM
To: Pietrini, Jill; Bost, Paul
Subject: FW: Exhibits

I left a voicemail for Paul yesterday, but no response. I need to speak with someone regarding the exhibits. It's been nearly a week now. Please let me know when someone is available asap.

Thanks.

Douglas D. Winter
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1/3/2011

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From: Doug Winter

Sent: Thursday, December 23, 2010 1:12 PM

To: 'Pietrini, Jill'

Subject: RE: Exhibits

Jill:

I just left you a message on your voicemail. As to the stip, there are a few discrepancies with the numbers, and we can hopefully resolve that without a problem. However, more fundamentally, as to gross receipts, the amount should be limited to Jem and Freeze, because they are the defendants in the case. The receipts from non-party licensees are relevant for the purpose of calculating Avela's license fees.

As to the exhibits, if we are able to pare them down, are Plaintiffs anticipating changing any of their exhibit numbers from the PTO? If not, it doesn't seem to me that we need to wait for the stip to be finalized. Please let me know your thoughts on this.

Doug

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From: Pietrini, Jill [mailto:JPietrini@manatt.com]

Sent: Wednesday, December 22, 2010 6:25 PM

To: Doug Winter

Cc: Bost, Paul; Mallen, Barry; Tim Ervin

Subject: Exhibits

Doug:

I received your voicemail yesterday about meeting about the trial exhibits. We need your signature on the stipulation about sales and revenue before we can do anything about exhibits. Assuming that you will actually sign the stipulation, that will eliminate a lot of trial exhibits both for live witnesses and for the deposition witnesses, and we can pare down the exhibits. You need to send us the signed stipulation or tell us that you are not signing it.

Also, have you updated your exhibit list?

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(EXHIBIT C)

EXHIBIT C

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEVADA

- - - - -x

FIFTY-SIX HOPE ROAD MUSIC LTD., and ZION
ROOTSWEAR,

Plaintiffs,

-against-

A.V.E.L.A.,

Defendant.

- - - - -x

DEPOSITION OF GREGG PARADISE

Westfield, New Jersey

Wednesday, October 14, 2009

REPORTED BY:

DANIELLE GRANT

1 G. Paradise

2 litigated as a counselor, litigator or trial
3 lawyer?

4 A Many.

5 Q More than 20? Just give me sort of
6 a ballpark figure?

7 A More than 20. I have never really
8 given thought to how many different cases I have
9 worked on.

10 Q Okay. And then I understand you
11 also do practice for the Trademark Trial and
12 Appeal Board?

13 A Yes.

14 Q And how many cases have you
15 litigated as a counselor, litigator or trial
16 lawyer in the TTAB?

17 A Again, it's been many different
18 cases. Really don't -- I've never thought of a
19 number.

20 Q Okay. More than 20?

21 A I think that's safe to say.

22 Q Has your practice exclusively been
23 in electrical property law since 1996?

24 A Yes.

25 Q How many right of publicity cases

1 G. Paradise

2 have you litigated as a counselor, litigator or
3 trial lawyer?

4 A Cases in which right of publicity
5 was an issue, one of the issues you're asking?

6 Q Right.

7 A Probably five to ten.

8 Q When was your first right of
9 publicity case?

10 A I don't recall.

11 Q Was it at Kenyon and Kenyon or
12 Lerner David?

13 A It would have been at Kenyon and
14 Kenyon.

15 Q How many right of publicity cases
16 have you had at Lerner David?

17 A At least three or four.

18 Q Have they all been for A.V.E.L.A.?

19 A No.

20 Q Do you refer to it as A.V.E.L.A. or
21 A.V.E.L.A.? I get two different views on this
22 one.

23 A I've -- usually refer to is as
24 A.V.E.L.A.

25 Q Okay. We'll use that, I think we're

1 G. Paradise

2 getting more accustomed to that anyway.

3 Okay. Of the three or four that
4 you've had right of publicity cases you've had
5 at Lerner David, how many have been for
6 A.V.E.L.A.?

7 A All but one of them.

8 Q Okay. And how many right of
9 publicity cases have you had under Nevada law?

10 A I believe just the present case. Or
11 the -- if you consider it one case or two cases,
12 I think there were two complaints that were filed
13 at different time, so there are two separate
14 cases.

15 Q Okay. And that's the one with the
16 Marley's, Marley Estate and Marley Company versus
17 A.V.E.L.A. and other defendants?

18 A Correct.

19 Q What other state laws have you done
20 right of publicity cases under?

21 A There have been a number. I can
22 think of offhand having looked into California,
23 New York, Indiana. I know that there are other
24 states that have come up in cases and also some
25 foreign jurisdictions.

1 G. Paradise

2 Q Okay. Do you, as part of your
3 practice at Kenyon and Kenyon, did you register
4 trademarks?

5 A I did.

6 Q Okay. And did you do registration
7 work for Mr. Valencia while at Kenyon?

8 A I don't believe we registered any
9 trademarks for him. We may have done some
10 copyright registrations.

11 Q Yeah, that was my next question,
12 actually, whether you had done -- registered any
13 copyrights for him?

14 A I don't recall myself doing it
15 personally, but there were other attorneys at
16 various different times over the years working on
17 A.V.E.L.A. matters. And I have some recollection
18 of copyrights, but I don't remember right now if
19 Kenyon filed them or Mr. Valencia filed them
20 himself.

21 Q Okay. How many lawyers at Kenyon
22 were working on Mr. Valencia's matters?

23 A Four or five at different times.

24 Q Who was the primary person working
25 for Mr. Valencia while you were at Kenyon?

1 G. Paradise

2 Q Okay. And on -- or in connection,
3 when you say "on," directly on the products
4 themselves?

5 A Correct.

6 Q Okay. And when you say "in
7 connection with," what are you referring to?

8 A Advertising that highlights Bob
9 Marley.

10 Q What do you mean by that?

11 A The advertising where it's, you
12 know, using the Bob Marley name in a trademark
13 sense.

14 Q I'm not sure I'm following you on
15 the trademark sense.

16 A I'm making the distinction between
17 trademark use of the name Bob Marley and a
18 factual or fair use, use of the name Bob Marley.

19 Q Okay. And you had a discussion with
20 Mr. Valencia about the distinction between a
21 trademark use and a descriptive use?

22 A At some point I did, yes.

23 Q Did you provide him with any cases?

24 A I did provide him with cases. I
25 don't recall if there were any specifically on

1 G. Paradise

2 that subject, but I provided him with numerous
3 cases over time.

4 Q Did you keep copies of those cases
5 in your file?

6 A The -- some of the cases would have
7 been printed out; some of them I would have
8 electronic copies of.

9 Q Do you keep a research clip when
10 you -- is it your normal practice to keep a
11 research clip or file when you do a project such
12 as this?

13 A I often have in some manner either,
14 like you say, a clip where it's literally just a
15 binder clip that has cases, or sometimes a folder
16 labeled legal research. I customarily do that.
17 Any cases that I sent to Mr. Valencia I would
18 have a copy of the e-mail sending it to him.

19 Q At the time that you rendered your
20 first conclusion, did you have any proposed
21 advertising for the Marley products that
22 Mr. Valencia was going to put out or authorized
23 to be put out by licensees?

24 A I don't believe I did.

25 Q Did you at any point ask him for

1 G. Paradise

2 ten.

3 Q And that was all before August 2006,
4 that was the question in case I confused you,
5 which I apologize for.

6 A Yes. And it probably would be about
7 the same answer for even after that, but yes, I
8 was answering prior to August 2006.

9 Q Okay. For those celebrity estates,
10 did any of those issues involve right of
11 publicity?

12 A Yes.

13 Q Any in Nevada, other than the Marley
14 issue?

15 A Not that I recall.

16 Q When you were doing your analysis of
17 Nevada right of publicity, did you contact any
18 Nevada lawyers?

19 A At some point in the process I did
20 have discussions with Nevada lawyers. I don't
21 recall if it was before or after the litigation
22 started, though.

23 Q Did you -- did you tell Mr. Valencia
24 the number of celebrity estates that you had
25 worked on before you did this analysis for the

1 G. Paradise

2 A I don't recall him ever asking me
3 that.

4 Q Did he ever suggest the conclusion
5 that he wanted with respect to the Marley rights?

6 A Well, I know that his desire was to
7 sell product.

8 Does that answer your question?

9 Q Sort of. Did he say, Look, you need
10 to find a waying, Gregg, that I can do this,
11 anything of that nature?

12 A I don't recall him saying it
13 anything like that, but he, as many clients do,
14 ask, you know, is there some way I can do this?
15 You know, can you find a legal way to do this?

16 I don't recall -- I don't recall
17 him specifically asking anything like that.
18 However, I do know that this opinion evolved
19 over time and I do recall that there was
20 something of a back and forth where I had some
21 initial thoughts and opinions on the matter and
22 he came back with additional facts or would
23 question things and then I would question the
24 matter further. And in some of those cases --
25 in this specific situation, I know that some of

1 G. Paradise

2 my conclusions changed over time.

3 Q And they changed in Mr. -- in favor
4 of using the images of Bob Marley?

5 A It was more -- two things that I
6 remember. One, I learned additional facts. The
7 main one that I learned was that they were not
8 going to be using the Bob Marley name on the
9 products. And I do know that changed my opinion
10 with respect to the -- the trademark issues.

11 And I also recall that there
12 were -- during this time period, two other
13 things. One, there were some unrelated cases
14 on the right of publicity area. The one I
15 recall specifically was the Marilyn Monroe Shaw
16 case decision that was issued. And I also
17 recall learning during the process of the -- I
18 believe it was the Tunes litigation, that was
19 also in Nevada, also involving 56 Hope Road.
20 And information that I have learned from both
21 the -- some of the decisions and facts in those
22 cases and additional facts of what
23 Mr. Valencia's plans were changed my opinions
24 at times.

25 Q And that was all after August '06?

1 G. Paradise

2 A Correct.

3 Q Did you also commit your opinions to
4 writing as to the Marley rights after the lawsuit
5 was filed?

6 A I don't recall ever doing that.

7 Q So it was only before the first
8 lawsuit, the '07, where you had writings with
9 Mr. Valencia as to your conclusions and analysis
10 of the Marley rights?

11 A There would have been after the
12 first lawsuit was filed, I'm sure. I know there
13 were additional written communications with
14 Mr. Valencia, but none of them would take the
15 form of what I would consider to be an opinion
16 letter like I know exists from before that time.

17 Q Were any writings that state or
18 express your conclusions or the reasons therefore
19 after the '07 case was filed? And I'm saying
20 '07, I know it was filed in '06, it ended in '07.

21 A I think we probably learned about it
22 in '07 maybe, I don't know. I don't recall the
23 specific dates of those. I do know that there
24 likely were writings regarding analysis of the
25 legal claims being made by 56 Hope Road in -- in

1 G. Paradise

2 that I gained concerning use of the Bob Marley
3 name by various different people.

4 Q Okay. Let's break it out one at a
5 time.

6 The registrations that you saw,
7 you saw those going to the USPTO.gov web site?

8 A I believe I saw -- I believe I
9 recall that there was at least one registration
10 for the name Bob Marley. I would have found it
11 through the USPTO web site, yes.

12 Q Did you conduct a more thorough
13 online search through Sagis or Dialogue or
14 anything along those lines for Bob Marley other
15 than your PTO search?

16 A I regularly use Sagis, I don't
17 specifically recall if I used it in this case. I
18 know that I did not get, for example, a Thompson
19 or Core Search comprehensive report ordered for
20 Bob Marley.

21 Q Okay. So no full trademark search
22 was ordered for Bob Marley?

23 A That's correct. I -- what I don't
24 recall is whether I just did a search on the
25 trademark office site or if I did that search

1 G. Paradise

2 through Sagis.

3 Q Did you -- when did you your search
4 on the PTO web site or if you did it on Sagis,
5 did you search just for the words "Bob Marley"?

6 A I know I certainly searched for
7 those words or probably would have just searched
8 Marley alone more broadly. I don't recall right
9 now whether I searched anything. I don't recall
10 if I researched anything else. I believe I also
11 searched for registrations owned by 56 Hope Road.

12 Q So you did what would be
13 characterized as an owner as e-search on the PTO
14 web site?

15 A Yes.

16 Q Did you search for any other related
17 entities of 56 Hope Road?

18 A I recall at one time I did a --
19 either a PTO or Sagis owner name search for a
20 related entity, Tuff Gong, that I believe was
21 owned by one of the Marley children, Rohan
22 Marley.

23 Q Did you ever search, do an owner as
24 an e-search for the Robert Marley foundation?

25 A I don't specifically recall that,

1 G. Paradise

2 but again, my owner as an e-search most likely
3 would have been just for the Marley name, not Bob
4 Marley. It was either for the -- I probably did
5 several. I -- I don't recall specifically, but I
6 believe -- my best recollection is that I would
7 have searched both Marley and 56 Hope Road as an
8 owner assignee, and at least Marley as a
9 trademark.

10 Q So to try to cover both bases,
11 looking for the word mark itself, Marley or Bob
12 Marley, looking for ownership by 56 Hope Road or
13 Tuff Gong?

14 A Right. My goal was to identify any
15 trademark registrations that could possibly be
16 asserted by anyone claiming rights in this area.

17 Q Okay. And which, you said you found
18 one registration for Bob Marley, did you have
19 find any other registrations owned by 56?

20 A I don't have a recollection at this
21 time.

22 Q What about Tuff Gong, what
23 registrations did you find for Tuff Gong? Or
24 applications?

25 A I have a vague recollection of

1 G. Paradise

2 knowledge that I learned probably first through
3 the Tunes case, that there were rights being
4 asserted by 56 Hope Road and I believe at least
5 one of their licensees, which indicated that
6 there were product in the marketplace.

7 Q With the name Bob Marley on it?

8 A I believe so.

9 Q Okay. And what about any images of
10 Bob Marley?

11 A I have a recollection of merchandise
12 with the image on it, with some images of Bob
13 Marley. So I have knowledge that there was such
14 merchandise in the marketplace.

15 Q That was put out by 56 or it's
16 licensees?

17 A Again, I believe I learned that
18 through the Tunes case. My hesitation is whether
19 that knowledge wasn't actually learned until the
20 lawsuit against A.V.E.L.A. was filed. And I
21 learned about the licensee and -- I have
22 forgotten which licensee was on which side of the
23 matter, but I know there was a licensee -- I
24 think it was Zion Rootswear, but I always forget
25 if it was Zion or Fame, which one was -- who's

1 G. Paradise

2 licensee.

3 But I did certainly learn through
4 the litigation involving A.V.E.L.A. that 56
5 Hope Road had a licensee who had merchandise in
6 the marketplace. I don't -- that's -- that's
7 why I have the hesitation that I'm not 100
8 percent positive that I learned it from the
9 Tunes case.

10 Q Okay. So when you said that you
11 reached a conclusion that there were trademark
12 rights in Bob Marley based on the registrations
13 and the use, is it you just can't remember what
14 that use was?

15 A I can't remember what the use was
16 or -- or when it was or if that came about later
17 on. For purposes of reaching my initial
18 conclusion about trademark rights, you know, and
19 the first opinion letter that I wrote, I didn't
20 feel I needed anything more than the registration
21 to know that there were rights in the name.

22 Q Okay. Did you reach a conclusion
23 for the Marley rights analysis, did you reach a
24 conclusion as to whether the Marley Estate family
25 had any right of publicity of rights?

1 G. Paradise

2 A Yes.

3 Q What was your conclusion?

4 A At what time?

5 Q In August of '06.

6 A What I don't recall because I -- I
7 remember that there were several -- as we have
8 talked about -- several e-mail written opinion
9 letters on this subject that I transmitted to
10 Mr. Valencia at different times. I don't recall
11 which ones specifically were in August and which
12 ones were later than that, because I believe it
13 occurred over a three month or four-month period
14 of time.

15 I initially reached the conclusion
16 that there was some question based on the
17 unknown fact of what state's law or what
18 country's law would apply to this situation.
19 And I believe I laid out the various scenarios
20 that could occur under different states' law
21 because there is the question of which -- a
22 choice of law question and then sort of a
23 two-level choice of question here. We don't
24 know what choice of law rules would be applied,
25 and then we don't know what law the court

1 G. Paradise
2 handling -- at this time -- a hypothetical
3 matter would choose to apply in this case. And
4 I believe I pointed out that the outcome would
5 be potentially different, depending on which
6 state or country's law applied in this case.

7 Q Okay. And that was in -- and we'll
8 go over some of your e-mails on this. But you
9 stated that there could be various scenarios
10 depending on which law applied?

11 A Yes.

12 Q That there could -- was it your
13 conclusion that there could be rights of
14 publicity in certain areas, but not in others for
15 Bob Marley?

16 A When you say "areas," are you
17 referring to jurisdictions?

18 Q Right, right.

19 A My conclusion was that if certain
20 states or country's law were applied, there was a
21 much higher likelihood that right of publicity
22 rights would be found to exist that potentially
23 were possessed by someone.

24 Q Okay. And you expressed this
25 conclusion to Mr. Valencia, both in writing and

1 G. Paradise

2 on the phone?

3 A I know for sure it was in writing.
4 I believe we also had discussions about it, so
5 yes.

6 Q Was it your understanding that
7 Mr. Valencia understood that there was a risk,
8 that the rights of publicity would be found
9 depending on which law was applied whether it was
10 Jamaica or another state?

11 MR. WINTER: Objection; calls for
12 speculation.

13 A I have no reason to believe that
14 Mr. Valencia did not understand my advice.

15 Q And your advice was there was a
16 potential for rights of publicity, that rights of
17 publicity could be found for Bob Marley if
18 certain laws applied?

19 A Yes.

20 MS. PIETRINI: Let's mark as Exhibit
21 160 an e-mail produced to us dated August
22 14th, 2006. And it was produced as
23 A001037 through 1038, and it's from Gregg
24 Paradise to Leo V.

25 (August 14, 2006 E-mail, Bates

1 G. Paradise

2 publicity was approved? Or approved with risk?

3 Or really, I can't say one way or the other?

4 A At this time I had not rendered an
5 approved or not approved opinion. It was more of
6 a what rights are out there and what can I think
7 about. My understanding was that there -- you
8 know, there -- there -- there wasn't a set
9 concept here yet, or at least I wasn't aware of
10 it at least, initially. So it really wasn't --
11 it was in the sense of a -- what rights are there
12 out there?

13 Q Okay. It wasn't -- would you
14 characterize Exhibit 160 as an approval or a go
15 ahead on the right of publicity?

16 A I wouldn't characterize it that way.

17 Q Would you characterize it more as "I
18 need to do more investigation before you can
19 proceed" type e-mail?

20 A I didn't really reach a firm
21 conclusion at this time on the right of publicity
22 issue. This was more, as I read it, a statement
23 of the -- the legal issues in connection with
24 right of publicity. You know, I had reached a
25 pretty firm conclusion on the trademark side, so

1 G. Paradise

2 I didn't pursue it further at this time.

3 Q Okay. And were there any -- did you
4 reach any conclusions as of August 14th, '06
5 about the copyright issues?

6 A My inquiry was based on the stated
7 assumption that there were no copyright rights in
8 the images of Bob Marley that were going to be
9 used. I think at this time -- and I'm just
10 looking at what I stated here -- my understanding
11 was public domain images including Bob Marley's
12 name and/or likeness.

13 Q How did you know that the images
14 were subject to public domain and no longer
15 subject to or were never protected under
16 copyright?

17 A At this time I was told that by
18 Mr. Valencia. It was an assumption in my initial
19 work.

20 Q Okay. And at that point he didn't
21 give you copies of every image that he -- before
22 you made this analysis? He didn't give you
23 copies of every image he intended to use?

24 A I believe I got images later on.

25 Q Okay. Would it be fair to say that

1 G. Paradise

2 about that comment?

3 A There were certainly further
4 discussions about licensing, because there were
5 many months of negotiations with various
6 representatives of the Marley rights. So I know
7 there were other discussions. I don't recall
8 this specific concept, though.

9 Q When you read this comment in the
10 August 15th, 2006 e-mail from Mr. Valencia, did
11 you understand that he was trying to use the
12 license as a bargaining chip?

13 A That's not how I understood it.

14 Q Okay. What was your understanding
15 then, because this is August '06. I'm talking
16 about the deals you may have had or discussions
17 later on.

18 A My understanding was that he was
19 looking to work out the license. The license
20 wasn't the bargaining chip. The rights in the
21 U.S. and the possible ability to engage in
22 activities outside of the U.S. were the
23 bargaining chips.

24 Q Okay. Did you understand that
25 Mr. Valencia had done any research himself on the

1 G. Paradise

2 Q Okay. And are you restating your
3 opinion that you stated previously to
4 Mr. Valencia, that it -- depending on the
5 jurisdiction, there would be rights of publicity
6 associated with Bob Marley?

7 A Portions of this e-mail are
8 restating portions of my prior opinions.
9 Portions of this are either further elaborating
10 on the same points or responding to different
11 points raised in Mr. Valencia's e-mail from the
12 day before.

13 Q Okay. And between -- I know that
14 you've got information and -- from Mr. Valencia
15 starting in August of '06, and then you've got
16 subsequent information.

17 The opinion that you have in your
18 February 20th e-mail, was it based on any new
19 information that you had received from
20 Mr. Valencia since the August 14th, 15th series
21 of e-mails?

22 A I don't recall whether there was
23 additional information received from
24 Mr. Valencia. But as I believe this was after
25 the lawsuit filed, there was additional

1 G. Paradise

2 apply.

3 Q Anything else?

4 A I don't recall if I received
5 anything else at this time.

6 Q Did you communicate that to -- or
7 this e-mail, the February 20th e-mail that's
8 communicating that point to Mr. Valencia,
9 correct?

10 A The point about the court in the
11 Tunes case applying the Nevada law was
12 communicated in this e-mail; that's one of the
13 things communicated, yes.

14 Q Did you ever tell Mr. Valencia that
15 there were other decisions in the Ninth Circuit
16 that had a different view, that were looking at
17 the place of domicile of the celebrity?

18 A I believe right in this e-mail I
19 mention the -- that there are Ninth Circuit cases
20 that apply the law of the jurisdiction of the
21 decedent.

22 Q Would you characterize this e-mail
23 as a -- an approval to go ahead or to continue
24 with using Bob Marley's image on merchandise
25 without violating rights of publicity?

1 G. Paradise

2 A Again, I wasn't asked in an approval
3 or disapproval standpoint. It was more of a
4 general legal advice regarding the matter. And
5 at this point, we already had litigation. So it
6 was just commenting on the law and my opinions as
7 to the likely outcome of the litigation.

8 Q Okay. So you didn't view this
9 e-mail as giving Mr. Valencia the green light to
10 continue his activities?

11 A I don't view this as giving him any
12 colored light for continuing with the activities.

13 It's -- it's -- I don't think this it's as
14 easily categorized in that manner as a green
15 light or an approval.

16 Q Well, how would you -- would you
17 characterize this e-mail any differently than you
18 characterize your August 14th and 15th series of
19 e-mails?

20 A Well, this is a little different,
21 because at this point we now have actual
22 litigation and a complaint setting forth causes
23 of action that I am responding to and a pending
24 motion for preliminary injunction. Before, it
25 was -- in the abstract, a -- we're thinking of

1 G. Paradise
2 coming out with a product like this, what do you
3 think? This is comments on, I got sued, what do
4 you think?

5 Q Okay. Did you see the -- at the
6 time you sent the February 20th e-mail, did you
7 see any of the artwork or photographs that
8 Mr. Valencia was using?

9 A I don't recall exactly when I saw
10 the photographs or artwork. I know at various
11 times I saw that. That should be reflected in
12 communications, either documents in the file or
13 e-mail communications.

14 Q And if they haven't been produced to
15 us, then they're being withheld on privilege?

16 A I have no idea.

17 Q Okay. Did you specifically ask
18 Mr. Valencia to provide you samples of what he
19 was going or -- or examples of what he was doing
20 before you sent this February 20th e-mail?

21 A I don't recall if it was before or
22 after this e-mail because I don't recall the
23 exact date of the complaint and the other
24 activities around that time. But I know that
25 when the complaint came in -- which I believe had

1 G. Paradise

2 and it also provided more facts to draw further
3 conclusions from.

4 Q But did it -- it didn't change the
5 actual analysis that you had back in August
6 '06 -- or conclusions, I should say?

7 A The difficulty is in conclusions,
8 because there weren't conclusions reached on
9 necessarily all of the issues. We've talked
10 about how the right of publicity was something of
11 an open issue. This provided some additional
12 material from which, you know, it seemed that
13 there was a pretty explicit consent from Bob
14 Marley to Roberto Robon to use and merchandise
15 photographs of Bob Marley -- these particular
16 photographs of Bob Marley.

17 Q You're looking at the second page of
18 your memorandum where it says that Robon said he
19 sold copies of pictures of Marley at numerous Bob
20 Marley shows?

21 A Yes.

22 Q Did Mr. Rabon tell you that he sold
23 any merchandise -- t-shirts, mugs, anything like
24 that bearing Mr. Marley's image?

25 A I don't recall him saying that.

Gregg Paradise

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF NEVADA

CASE NO.: 2:08-CV-00105-PMP-GWF

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FIFTY-SIX HOPE ROAD MUSIC LTD., a Bahamian corporation; and ZION ROOTSWEAR, LLC a Florida limited liability company,

Plaintiffs,

-against-

A.V.E.L.A., Inc., a Nevada corporation; X ONE X Movie Archive, Inc., a Nevada corporation; Jem Sportswear, a California corporation; Central Mills, Inc. (Freeze), a New York corporation; and Leo Valencia, an individual,

Defendants.

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AND RELATED COUNTERCLAIM.

- - - - -x

DEPOSITION OF GREGG PARADISE

New York, New York

Thursday, April 8, 2010

REPORTED BY:

DANIELLE GRANT

1 G. Paradise

2 Q If you look at the bottom part of
3 the e-mail which is under -- it looks like it's
4 an e-mail from Mr. Valencia to you dated
5 September 19, '06, he states, "On the Bob Marley,
6 we should not have any issues with trademark if
7 we leave his name off any products since we do
8 not have any right of publicity issues, correct?"

9 Did you -- and I'm looking at your
10 response above about right of publicity. Were

11 you advising Mr. Valencia that there were no
12 rights of publicity associated with Bob Marley?

13 A That is not what I was saying in
14 this e-mail.

15 Q What were you conveying? What was
16 the message you were trying to or that you were
17 conveying to Mr. Valencia?

18 A I was conveying to Mr. Valencia that
19 different courts ruled differently on right of
20 publicity issues, and it was something of a legal
21 issue in flux. And depending on which state a
22 suit was filed in and how the different facts and
23 laws came out, the ruling could be different.

24 I was opining here that -- or
25 really just discussing a court decision from a

1 G. Paradise
2 court in Nevada and its holdings that in that
3 case were favorable to Mr. Valencia's possible
4 use of images of Bob Marley and right of
5 publicity.

6 Q So is it fair that your e-mail was
7 telling Mr. Valencia that there may, in fact, be
8 a right of publicity associated with Bob Marley,
9 depending on whose law applied?

10 A I don't know if that's how I would
11 put it. You know, in theory there should be
12 something of an answer. It's part of the
13 frustration of this issue where during this time
14 period courts and legislatures change the law at
15 times, you know.

16 It's not so much that there could
17 be a right of publicity, it's that maybe one
18 court would find that there is one based on one
19 set of laws and another court would find that
20 there isn't based on another set of laws.

21 Q These e-mails were not -- I want to
22 be clear on this point -- were not telling Mr.
23 Valencia that there absolutely was no right of
24 publicity associated with Bob Marley?

25 A That's a fair statement.

1 G. Paradise
2 action by legislatures that happened that I
3 believed happened after this date. So there
4 were -- it was an evolving process.

5 Q Okay. And the facts and the court
6 decisions that you uncovered after the series of
7 e-mails, did that change your opinion or analysis
8 that there may be -- or that a court could rule
9 that rights of publicity were associated with Bob
10 Marley?

11 (The requested portion of the
12 record was read back.)

13 A I don't believe it changed my
14 opinion as to what I thought the answer should
15 be. I believe, if I am remembering the
16 chronology right, that the Shaw case involving
17 Marilyn Monroe, that there were decisions after
18 this time that strengthened my belief that a
19 court would find no right of publicity; however,
20 there were also developments in the laws in
21 California that if California law were to apply,
22 which I didn't think it would in this case or
23 should in this case, but if it did apply would
24 change the result and possibly find that there
25 was a right of publicity.

Gregg Paradise

1 G. Paradise

2 Marley's image?

3 A I don't know that I provided that

4 specific advice. I do know that I advised Mr.

5 Valencia that terms such as this, if they had

6 been used as a trademark previously by another

7 entity could be problematic, but that if they

8 hadn't been, then there were no trademark

9 problems.

10 Q Do you know who Mr. Valencia was
11 licensing this image to?

12 MR. WINTER: Objection, lacks
13 foundation.

14 A I don't recall whether Mr. Valencia
15 had actually licensed the image or was just
16 making it available for licensing, and I remember
17 that there was another entity involved who was
18 the co-defendant in the first case that was
19 displaying this image at their booth at the trade
20 show. But I don't know if there was a formal
21 license in place at that time or it was just an
22 offer to license and they were looking to see if
23 there was anyone interested in merchandising the
24 design.

25 Q Was it your understanding that this

1 G. Paradise

2 right of publicity issue.

3 Q Did it also apply to the use of song
4 titles?

5 A Without being able to see if the
6 redacted section discussed legal issues relating
7 to song titles, I don't know. If that -- it
8 would only have related to what was in this
9 e-mail.

10 Q Do you recall ever telling Mr.
11 Valencia or anyone else at A.V.E.L.A. that it was
12 okay to use song titles of a celebrity directly
13 on products?

14 A I recall discussions with Mr.
15 Valencia about that issue. My advice
16 consistently was, it depends on what the prior
17 use or rights through obtaining a registration of
18 any other entity, not necessarily just the, you
19 know, the singer or songwriter but production
20 company or even some third party. It depended on
21 if anyone had previously made trademark use of
22 that song title. If it was merely the title of a
23 song on an album. It was my opinion that that
24 alone did not result in trademarks rights in the
25 song title.

1 G. Paradise

2 Q If the song title was also used
3 directly on clothing, would you consider that a
4 trademark use?

5 A It would depend on how it was used.
6 It's hard to say in the abstract because there
7 are a lot of times where you may have a concert
8 T-shirt that lists the ten songs on an album on
9 the back of a T-shirt. I would not consider that
10 to be a trademark use.

11 It would also depend on, was it
12 part of some other work of art that it just
13 appeared in? There are a lot of factors that
14 would go into whether it's actually a trademark
15 use and whether someone has, by that use,
16 generated trademark rights in the song title.

17 Q Okay. What about with the song
18 title appearing underneath an image of the
19 celebrity? By itself, not in a context of
20 listing, like the example you gave on the back of
21 the shirt.

22 MR. WINTER: Objection, incomplete
23 hypothetical.

24 A That is something of a, I would have
25 to say, borderline case because there are other

1 G. Paradise

2 issues. If it appeared as part of -- like I'm
3 saying, if it appeared as part of some prior
4 work, it might be considered to be either a fair
5 use or still not trademark use, you know.

6 Traditionally trademark use is a
7 brand association. If you use that -- you
8 know, the clear cases are you use it on a hang
9 tag or on a label in a trademark fashion, that
10 would clearly be trademark use. Just printing
11 the name of something on a T-shirt, in a lot of
12 cases it wouldn't be. If you do it and you're
13 Nike and you write Nike with a swoosh and
14 that's what's on the front of the shirt, that
15 probably is a trademark use in association with
16 clothing.

17 But, for example, in the case of
18 Exhibit 314 and the image there, that's less of
19 a clear question. You know, I recall that the
20 advice that I provided to Mr. Valencia was that
21 I thought that on whole, without anything else,
22 that that should not be a trademark use but
23 that it was a closer call and depending on
24 other facts courts could go either way on that
25 type of an issue.

1 G. Paradise

2 Q And you're referring to the use of
3 "One Love" underneath Mr. Marley's image?

4 A Correct.

5 Q Okay. And that your advice to Mr.
6 Valencia was, that could be considered a
7 trademark use or it may not?

8 A My advice was that, I did not
9 believe it should be considered a trademark use,
10 but that it's something that courts -- it's in
11 the realm of possibility that courts could find
12 it to be trademark use, especially depending on
13 what other facts there were relevant to the
14 matter.

15 Q And did you consider in rendering
16 that advice that one could establish trademark
17 rights in a use of a name on the front of a
18 T-shirt and through proof of secondary meaning?

19 A Well, if someone could establish
20 secondary meaning, and that secondary meaning
21 would have to be not just that "One Love" is
22 associated with Mr. Marley, but that use of "One
23 Love" is exclusively associated with the
24 distributor of whatever goods there are because
25 the T-shirt, the distributor of the T-shirt or

1 G. Paradise

2 some licensing entity that has rights to it, if
3 that could be established then, yes, you could
4 establish trademark rights. My belief was that
5 would be extremely difficult to establish based
6 on just use like this.

7 Q And did you tell Mr. Valencia that
8 there was a risk that this could be considered
9 trademark use?

10 A I believe we discussed that there
11 certainly were risks associated with this.
12 Courts gets things wrong all the time. And there
13 could be other facts that come to bear that
14 influence this, but just based on applying a song
15 title to a T-shirt, if that's the only fact, it's
16 my opinion that that should not -- is not a
17 trademark use and should not generate trademark
18 rights for anyone.

19 Q But you did -- you did advise that
20 there were risks associated with it too, Mr.
21 Valencia?

22 A Based upon the unknown and the
23 vagaries of the court systems, yes.

24 Q Did you ever consider whether the
25 use of a song title on the front of a T-shirt

1 G. Paradise

2 would create liability under Section 43(a), false
3 association or false endorsement?

4 A In any analysis of trademark rights,
5 you're always looking at those kinds of, sort of,
6 generic 43(a) claims. I don't recall if I
7 specifically advised him separately as to
8 liability under Section 1114 for trademark
9 infringement versus 1125(a) for a false
10 association or some other kind of general unfair
11 competition, but I would always consider both of
12 those issues in reaching a legal conclusion.

13 Q Did you advise Mr. Valencia that
14 there was a risk that his use of song titles
15 could create liability for him under Section
16 439(a) of the Lanam Act (phonetic)?

17 A If a third party could establish
18 superior trademark rights -- oh, you're limiting
19 this to 43(a) now?

20 Q Yes.

21 A I don't recall discussing it
22 specifically with him as a separate cause of
23 action. You know, it's something that
24 experienced trademark practitioners easily
25 disassociate but is, I guess, less easy to

1

G. Paradise

2

understand for a lay practitioner. But my -- you

3

know, my opinion on this was that use of a song

4

title in that manner would not cause a false

5

association. The false associate still needs to

6

be, you know, somehow related to rights or, you

7

know, a belief that the entities are related,

8

affiliated, sponsored, licensed, something like

9

that. It's not licensed, but -- so my opinion

10

was, just use of a song title in this manner

11

would not be -- should not be actionable.

12

Q Do you understand Roots Rock Reggae

13

to be a song title of Bob Marley?

14

A I don't know that I ever had that

15

understanding, and I don't recall that today.

16

Q But you understand that's a

17

registered mark, based on the exhibit we've

18

looked at, the PTO Exhibit 311; right?

19

A Yes. Based on my review of 311,

20

Exhibit 311, as of July 1, 2008, this Roots Rock

21

Reggae was a registered mark.

22

Q And have you ever registered a name

23

that appears on the front of a T-shirt in your

24

practice?

25

A I am sure I have registered marks

1 G. Paradise

2 because I know I've registered many marks in the
3 clothing field where that mark would appear on
4 the front of a shirt. I don't recall registering
5 one where that was the only use. My
6 recollections are that I would register ones
7 where it appeared on a hang tag or a label or
8 both.

9 Q So you've never registered anything
10 that -- where it's just a name on the front of a
11 T-shirt without use on a hang tag or a label?

12 A Not that I can recall. And it would
13 be surprising because I don't know think the
14 trademark office would except that as a specimen.

15 Q If you look back at Exhibit 311,
16 which is the specimen that was printed from the
17 PTO website.

18 A Um-hmm.

19 Q And you see the use of Roots Rock
20 Reggae is on the front of the T-shirt; correct?

21 A Yes. It's actually Roots Rock
22 Reggae Festival.

23 Q Right. Do you do much work for --
24 registration work for musicians or entertainment
25 properties?

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1 G. Paradise

2 hypothetical, calls for speculation,
3 lacks foundation.

4 A It would depend on whether there
5 were any other facts that would call into
6 question a registration.

7 Q Assume that a song title is a
8 Federally registered trademark and Mr. Valencia
9 wants to use it right underneath the image of the
10 particular celebrity whose song it is, would you
11 advise Mr. Valencia that that was permissible?

12 MR. WINTER: Same objections,
13 incomplete hypothetical, lacks
14 foundation.

15 A I recall actually having
16 discussions of -- I don't know if it was -- if
17 there was an actual registration in place, but
18 the question of what constitutes trademark use
19 and whether use in that manner was trademark use.
20 It's my opinion that merely placing a song title
21 on the front of a T-shirt is not trademark use.
22 If it's not trademark use, it shouldn't be a
23 trademark infringement.

24 Q Well, do you -- I understand from
25 your e-mails you advised Mr. Valencia that he

1 G. Paradise
2 could not use Bob Marley directly on the
3 merchandise that he was licensing; right?

4 A Yes, I advised against doing that.

5 Q Okay. And Bob Marley is a
6 registered trademark as you found from your
7 searches through the Patent and Trademark Office;
8 correct?

9 A I believe that's what I found, yes.

10 Q So Mr. Valencia absolutely could not
11 use Bob Marley's registered trademark on the
12 clothing, but it could be okay if he used a
13 registered trademark that was also a song title?

14 A That's not -- I see where the
15 disconnect is here.

16 I advised him that he shouldn't
17 use the trademark Bob Marley. I believe my
18 advice would be the same for any registered
19 trademark that there was a great risk if you
20 use, whether it was a song title, the name or
21 any word fanciful, arbitrary or otherwise, if
22 someone has a registered trademark for
23 clothing, your use in a prominent fashion on
24 clothing of that mark is inadvisable because
25 there's a great risk.

1 G. Paradise

2 At the same time, it's my opinion
3 that simply putting that name in a
4 non-trademark fashion on piece of clothing, not
5 in a way that is typically used by a trademark.

6 For example, trademark owners will
7 often put it on a breast patch or on a pocket
8 or something like that. That's, you know, like
9 the polo logo. I don't have one on my current
10 shirt, but the one I wore yesterday I know had
11 the logo image on the breast area. That's a
12 typical way that trademarks are used.

13 It's my belief that using a name,
14 whether it's registered trademark or not, in
15 another fashion is not a trademark use and
16 should not subject you to liability. However,
17 it's a -- what I'd say, a dangerous area
18 because if there are any other facts that work
19 against you, it's going to push you over the
20 edge very quickly, so it's not an advisable way
21 to proceed.

22 So there's a difference between my
23 advice, which is often from a practical
24 business standpoint of, it's just too likely
25 you're going to get whether you ultimately

1 G. Paradise
2 should prevail on that suit or not, it's not
3 worth it, you shouldn't do it versus what I
4 think the law it.

5 Q Okay. And you provided that advice
6 or you did not provide that advice to Mr.
7 Valencia in terms of there could be a substantial
8 risk by using a registered trademark on the front
9 of the clothing?

10 A I do not recall having that
11 discussion in connection with anything other than
12 the words "Bob Marley," which I clearly advised
13 you shouldn't do.

14 The issue, you know -- so I know I
15 definitely advised him that it's certainly not
16 suggested and I advised that that was not a
17 good way to proceed. But I don't believe I
18 ever told him that any use of Bob Marley in any
19 form on clothing would absolutely be an
20 infringement. There's two different things.

21 Mr. Valencia, his primary interest
22 was in getting legal advice but with an idea of
23 how he's trying to conduct business and, you
24 know, selling these T-shirts but paying a
25 million dollars in legal fees to defend

1 G. Paradise
2 yourself, even if you ultimately win, is a loss
3 at the end of the day. So he tried to steer
4 clear of things that even if he technically
5 might be right, he might choose not to do it
6 for business reasons because people would file
7 overzealous lawsuits.

8 MS. PIETRINI: Could you read back
9 that answer please? Sorry, it was too
10 long.

11 (The requested portion of the
12 record was read back.)

13 Q When we were talking about the
14 specimen for the Roots Rock Reggae registration
15 which I think we've marked as Exhibit 311, do you
16 understand the term specimen to refer to the
17 evidence of use provided to the U.S. Patent and
18 Trademark Office?

19 A Yes, I do.

20 Q And is it also your understanding
21 that the Trademark Office bases its decision on
22 whether to register a mark in part on the
23 evidence of use that's submitted?

24 A The Trademark Office makes an
25 evaluation of whether the specimen shows use of

PROOF OF SERVICE

I, LaTrina A. Martin, declare as follows:

I am employed in Los Angeles County, Los Angeles, California. I am over the age of eighteen years and not a party to this action. My business address is MANATT, PHELPS & PHILLIPS, LLP, 11355 West Olympic Boulevard, Los Angeles, California 90064-1614. On January 3, 2011, I caused the forgoing document:

PLAINTIFFS' MOTION IN LIMINE #9 TO EXCLUDE CERTAIN DESIGNATED DEPOSITION TESTIMONY OF GREGG PARADISE BASED ON IT BEING IMPERMISSIBLE EXPERT TESTIMONY

including any and all exhibits, to be electronically filed with the Clerk of Court using the CM/ECF system, which will effectuate service of said document upon the following counsel of record:

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I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made and that the foregoing is true and correct.

Executed on January 3, 2011, at Los Angeles, California.

/s/ LaTrina A. Martin
LaTrina A. Martin

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